

REMARKS

This paper is filed in response to the office action mailed on October 12, 2005. Claims 1-17 stand rejected; claims 1, 7, 10 and 13 have been amended; claim 14 has been previously cancelled; claims 1-13 and 15-17 remain pending.

At the outset, the Patent Office rejects claims 1-13 and 15-17 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement or the enablement requirement. The paragraph on page 2 is unclear. Regardless, the independent claims have all been amended to make it clear that the base materials added are free of colorant "other than titanium dioxide" which the Patent Office considers to be a colorant for the color white. The amendments to the independent claims are consistent with the specification as filed. The base suspensions which are added first and last can contain titanium dioxide, but no other colorants for colors other than white. Applicant respectfully submits that the rejection of the claims under 35 U.S.C. § 112, first paragraph has been traversed.

The office action also rejects claims 1-17 under 35 U.S.C. § 103 as being unpatentable over WO 02/15735 ("Unilever") in view of U.S. Patent No. 6,767,126 ("Miller").

The secondary reference, Miller, is not prior art under § 102 as therefore the obviousness rejection is improper. The inventors of Miller and the present application are the same; the assignees are the same. Miller was filed on March 19, 2002 and not published until September 25, 2003. The present application was filed after Miller, but before the publication of Miller. Because Miller is not a prior publication, use or invention *by others*, Miller is not prior art under § 102(a) or § 102(e). The publication of Miller is not a year before the filing date of the present application and therefore § 102(b) does not apply. Because §§ 102(c), 102(d), 102(f) and 102(g) also do not apply, Miller is not prior art and cannot be used in an obviousness rejection. Therefore, for this reason alone, the obviousness rejection is improper and must be withdrawn.

Nevertheless, each independent claim has been amended to make it clear that the first base suspension added to the container is free of colorant *other than titanium dioxide* and is used to coat the bottom and at least part of the sidewall of the container to prevent colorants *other than titanium dioxide* from engaging the bottom and sidewall of the container. See the specification at page 5, lines 5-12. This step is not taught or suggested by Unilever.

Unilever does not recognize the problem of colorants other than titanium dioxide coating the inside surfaces of a clear container resulting in streaks that are not removed even after a vigorous mixing. See the present specification at page 1, lines 21-32.

Further, the independent claims have been amended to make it clear that the final base suspension added to the container is also free of colorant other than titanium dioxide and it is *the last ingredient added* thereby sandwiching the suspensions containing colorant between the first or lower and last or upper base suspensions. This feature is not taught or suggested by Unilever.

Finally, the elements of claims 2, 7, 10 and 13 relating to the stopper and the preventing of colorants from migrating up the neck of the bottle during mixing have not been addressed in the pending or the earlier office actions. See the specification at page 7, line 29 to page 8, line 18. Unilever does address this problem and the Patent Office has not addressed the elements of claims 2, 7, 10 and 13 as well.

Returning to the rejections set forth in the office action, Applicant respectfully submits that amended claims 1, 7, 10 and 13 are all allowable over any hypothetical combination of Unilever and Miller for the following reasons. Under MPEP § 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); see also MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Unilever does not teach or suggest all of the limitations of the pending independent claims. Specifically, Unilever in no way teaches or suggests adding a first base suspension that is free of colorant other than titanium dioxide to a container *to coat the bottom and lower sidewall of the container prior to the addition of suspensions that contain colorant*. See the specification at page 5, lines 5-12.

Unilever does not teach or suggest adding a base suspension other than titanium dioxide *last and after all of the other ingredients have been added* whereby the last base suspension is also free of colorant other than titanium dioxide.

Applicant respectfully disagrees with the position taken by the Patent Office on page 6 of the office action. The order of the claimed steps must be considered and the novel order as claimed is simply not taught by Unilever. Unilever does not address the problem of mixability of cosmetics preparations.

Page 4 of Unilever in no way teaches or suggests adding "suspensions comprising one or more colorants on top of a first base suspension" as alleged by the Patent Office. Instead, page 4 of Unilever merely provides two groups or classes of performing agents that can be modified when customizing a personal care formulation. Unilever suggests no order of addition of its ingredients. Unilever in no way makes it clear that any one of these classes includes base suspensions and Unilever in no way suggests that base should be added to the container *first and last* as recited in each pending independent claim to avoid colorant streaks on the inside surface of a clear container. It is unclear why the Patent Office cites page 7. Page 7 of Unilever has nothing to do with bases, colorants and mixing problems.

Instead, Unilever only suggests at page 5, lines 10-13 that "certain products will have greater stability if dosed in a specific sequence such as for body toner where the product base should be dosed first, for maximum stability." This statement and teaching has nothing to do with mixability. Each pending independent claim of the present application requires a specific order where a base to be added first to coat the bottom and lower portion of the sidewall to thereby keep colorant off of this portion of the container. See the specification at page 7, lines 10-28.

The claims require the coating of the bottom and lower sidewall with base to be followed by one or more suspensions containing colorants, followed by a final base dose that is last ingredient added. The base suspensions must be free of colorant other than titanium dioxide.

Because Unilever does not even address the problems of mixability or the coating of the sides or bottom of a clear container with colorant, and further because Unilever in no way teaches or suggests adding a base first, followed by colorants, followed by a final

base, Unilever is clearly deficient as a base reference for pending independent claims 1, 10, 7 and 13.

Further, Unilever does not teach or suggest the use of a stopper to keep colorants off of the inside of a bottle neck. The Patent Office has not addressed this issue.

The Miller reference merely teaches a gyroscopic mixer and, even if it were prior art, Miller could not supplement Unilever with respect to any of the deficiencies addressed above.

Accordingly, no combination of Miller and Unilever teaches or suggests every limitation of independent claims 1, 7, 10 and 13 and therefore claims 1-17 are clearly allowable over any hypothetical combination of these references.

If the examiner disagrees, applicant invites the examiner to telephone the undersigned at the number listed below to discuss this application further.

An early action indicating the allowability of this application is respectfully requested.

The Patent Office is hereby authorized credit any overpayment or charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 50-3629.

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Respectfully submitted,

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